

### **REMARKS**

Claims 1-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and 75-77 remain pending and presented for review. Claims 1, 2, 6, 7, 18, 26, 27, 29, 30, 32, 33, 61, 62, 73, and 77 are amended. Support for the amendments can be found in the specification. No new matter is believed to be added. Favorable reconsideration and allowance are requested in light of the foregoing amendments and the remarks which follow.

#### **I. Rejections under 35 USC §103**

Claims 1-9, 16-18, 29-33, 36, 57, 59-70, 72, 73, and 75-77 stand rejected under 35 USC §103(a) as being obvious over Herzog-Mesrobian et al. (USP 6,108,974) in view of Rusert et al. (USP 6,371,645). Claims 10, 11, and 19-27 are rejected under 35 USC §103(a) as being obvious over Herzog-Mesrobian et al. in view of Rusert et al., and in further view of Gilbert (USP 6,505,425).

##### **A. The Law**

It is well-settled law that to establish a *prima facie* case of obviousness, three basic criteria must be met:

1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

2) there **must be** a reasonable expectation of success; and

3) the prior art reference (or references when combined) must **teach or suggest all the claim limitations.**

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, **not** in Applicants' disclosure. (Emphasis added.) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is **some** teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (Emphasis added.) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988). Furthermore, in *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed.Cir.2002), the Federal Circuit held that the Board's reliance on "common knowledge and common sense" of equivalents did not fulfill the agency's obligation to cite references to support its conclusions. Applicants submit that the Office Action fails to establish a *prima facie* case of obviousness.

## **B. The References**

### **1. Rusert et al. Reference**

Claims 1-9, 16-18, 29-33, 36, 57, 59-70, 72, 73, and 75-77 stand rejected under 35 USC §103(a) as being obvious over Herzog-Mesrobian et al. in view of Rusert et al. However, Rusert et al. is non-analogous art as it discloses an open mesh bag for produce and method of making the same. See Rusert et al., Abstract, Col 1, lines 6-9, and Col. 2, lines 6-31. In fact, Rusert et al. also teaches away from sewing seams when it says, "Sewn seams add cost and are often ineffective due to the small surface of the open mesh fabric." Col. 1, lines 59-61. See also Col. 1, lines 25-27. Instead Rusert et al. discloses gluing to the mesh bag via heat sealable labels. See, e.g., Col. 2, lines 6-31; Col. 10, lines 43-60. The present invention does not glue seams because of the stretch nature of the fabric. For example, the tension created after stretching the fabric over the pot would not allow for a glued-on ornament (patch) or seam because of possible tearing. Further, sewing is preferred to maintain the tensile strength needed to affix the fabric up and over the top rim and under the bottom. Also, heat applied to the inventive apparatus would melt the fabric and destroy the film.

In addition, while the labels in Rusert et al. are attached permanently by heat (heat sealable) to the mesh bag, preferably the labels of the present invention (i.e., the film labels that are *friction* attached to the polyurethane coating on top of the fabric purposely) are designed to be removed and restored as desired. (Intentionally not permanent- rather static cling). See amended claim 6. Moreover, it was discovered that not all film labels would stick and that the coating of the fabric and film must be compatible so that they achieve static cling.

Further, the contents of the Rusert et al. produce bag do not dictate the contour of the label that is affixed to the outside of the inventive vessel because the Rusert et al. label is put on before the bag is filled. Conversely, the label of the present invention must be put on the vessel

after the inventive sleeve is put on and must be of a certain contour and size so that it will not pull away from the arc of the pot.

Furthermore, per the Examiner, Rusert et al. in Fig 1 and 2 allegedly discloses an apparatus that is capable of containing a pot even though this is not suggested or disclosed. Nevertheless, for the inventive sleeve to fit properly on a pot, the sleeve needs an open end. We do not see how Rusert et al. could fit in this manner as the sides of the bag shown are completely sealed. Combining Rusert et al. with Herzog-Mesrobian et al. thus is unworkable in this respect.

Also, nowhere does Rusert et al. talk about applying ornamentation so as to communicate emotion or advertisement. Amended claim 21 or claim 11; See also amended claim 30. Rather, as there is no disclosure in Rusert et al., one can only imagine that the Rusert et al. label talks about the contents of the bag and is only descriptive of the produce located inside.

Rusert et al. also teaches high speed mass production using automated equipment whereas in the present invention, each ornamentation is individually applied by a user. For example, sewing on patches is the only way to apply ornamentation to the arc of the pot and then it can only be done in a certain way because a non-stretch fabric is being adhered to a stretch fabric that needs to move from a stretched state to a non-stretched state as it is put on and off. Also, amended claim 7 indicates the materials for the inventive sleeve would be in kit form. This is not disclosed or suggested in Rusert et al. or Herzog-Mesrobian et al.

Also, the sleeve may include a pocket that could contain, e.g., a photograph of a loved one or a pet. See, for example, amended claims 26 and 27. These features neither disclosed nor suggested in the cited prior art.

Finally, neither Rusert et al. nor Herzog-Mesrobian et al. disclose a second sleeve (amended claim 32), overlapping finger tabs (amended claim 33), a sleeve that is reversible (amended claim 62), or sewing coated and uncoated stretch fabrics together to make a base pattern (amended claim 73).

## **2. Gilbert Reference**

Gilbert is cited against claims 10, 11, 19-27 to shore up deficiencies in Rusert et al. and Herzog-Mesrobian et al.

Gilbert discloses a floral container that is formed from receptacle-forming panels joined together to form a receptacle for a flower bouquet or other plants wherein one or more panels are removably joined to one of the receptacle-forming panels so that it may be selectively removed from the receptacle. Gilbert, See, e.g., Abstract. Gilbert discloses that the removable panel may include indicia corresponding to such events as a special holiday. See Gilbert, e.g., Col. 3, lines 10-16. However, there is no disclosure of applying the indicia directly to a stretchable sleeve. Moreover, the cited Gilbert patent cannot cure these deficiencies in Rusert et al.

Thus, the Applicants respectfully traverse the rejections because, *inter alia*, there is no teaching or suggestion to combine the Herzog-Mesrobian et al. patent with the Rusert et al. and/or Gilbert patents to produce an apparatus of the claimed type.

#### **C. Expectations of Success of Combining References**

Furthermore, even if the cited references were combined, the invention would not result. For example, it was discovered that decorative ribbons, belts, or ties would not stay affixed to the rim of the pot (over the inventive sleeve) because either 1) the materials were too slippery, 2) the ties would loosen due to normal stretching, or 3) gravity would eventually pull the heavier materials down (e.g., a belt). By applying a smaller stretchable layer of fabric on top of the inventive sleeve over the rim, a crevasse was created in which the ribbon etc would stay secure. To make this work, the fabric was cut in the direction of the stretch so the fabric would roll bilaterally (on the top and bottom) thus creating the edges for the crevasse. See, e.g., amended Claim 32. Thus, many of the seemingly cosmetic improvements over the prior art have a functional purpose.

Also, with the larger size pots that are made of plastic (not clay), the additional layer holds the inventive sleeve in place because with plastic pots the inventive sleeve slips off because plastic is too slippery to hold the fabric covering. See, e.g., Claim 77. So the plastic blow molded pots (17, 19, and 21 inch pots that are used outdoors) have a ridge built in under the rim so the additional layer holds the inventive sleeve up over the rim. See, e.g., Claim 32.

Further, as claimed in Claim 30, three-dimensional objects such as decorative beads, dangling jewelry, etc. can be attached to the additional layer and/or easily applied directly as

decorations to the sleeve. It is much more difficult to attach ornamentation to the inventive sleeve if one were to attach such items directly to the fabric.

Furthermore, even if there were some motivation to combine these references, many of Rusert et al.'s disclosed displaying means would not work on the claimed sleeve. For example, pasting ornamentation as taught in Rusert et al. to an elastic sleeve will likely result in an impermanent bond. As the sleeve expands and contracts, the paste or glue bond would likely weaken and eventually the ornamentation would fail.

It was also learned that in applying the patches (non stretch material) to the stretch fabric of the inventive sleeve adjusting the end stretch point was necessary in order to keep the patch from puckering. In other words, it is a physical impossibility to attach the non-stretchable patch to a stretch fabric in the way that Rusert et al. teaches. It was discovered through trial and error that the following had to be done to apply the patch: 1) develop a special frame (like a hoop) to pre-stretch the fabric then, 2) mark the patch placement, and then 3) attach it with stretchable thread.

Finally, with regard to the film, Applicants underwent much trial and error to find a film that could go on and off to switch the inventive sleeve from a greeting to home décor. See, e.g., page 7, lines 18-20. As a greeting, it could be easily sent (off the pot) in an envelope through the US mail. As such, the consumer had to have the ability to easily put the inventive sleeve on and then stick the label on. Then when the special event or holiday is over – be able to remove the label. Holiday gift packages could contain multiple labels in a gift package with each label designed for a different special event or holiday – such as Thanksgiving, 4<sup>th</sup> of July, Christmas etc. See, e.g., page 7, lines 18-20.

## **II. Swearing Behind Gilbert and Rusert et al.**

Even if the above amendments and arguments do not prove successful, a Declaration from inventor Patricia L. Herzog-Mesrobian et al. is submitted showing that she was in possession of key elements of the invention before the filing dates of Gilbert and Rusert et al. and that she diligently worked to reduce them to practice. See attached Declaration. Such a

Declaration is sufficient to effectively swear behind the cited reference for all they teach or suggest.

### **III. Conclusion**

In light of at least the above amendments and arguments, it is submitted that claims 1-11, 16-27, 29-33, 36, 57, 59-70, 72, 73, and 75-77 are in compliance with 35 U.S.C. §103 and each defines patentable subject matter. A Notice of Allowance is therefore respectfully requested.

A check in the amount of \$60.00 for a one-month extension of time is enclosed.

The Examiner is invited to contact the undersigned if it would help expedite the prosecution and allowance of this application.

Respectfully submitted,



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